REMARKS

Restriction Requirement

The Office has set forth a restriction requirement. In particular, the Office requires Applicants to elect one of the following groups:

(I) Claims 28-37, only drawn to a method of creating a transgenic plant comprising a DNA molecule encoding an acidically modified nucleic acid binding protein containing an N-terminal extension of acidic amino acid residues (class 800, subclass 278), and

(II) Claims 28-56, drawn to a method of creating a transgenic nonhuman animal utilizing a DNA molecule encoding an acidically modified nucleic acid binding protein containing an N-terminal extension of acidic amino acid residues, and transgenic nonhuman mammal whose cells comprise a recombinant acidic dominant negative polynucleotide sequence, and a method for producing the same transgenic nonhuman mammal (class 800, subclasses 14 and 21).

The Office further requires an election of one of the following proteins: (1) Fos, (2) Jun, (3) GCN4, (4) VBP, (5) GBF-1, (6) opaque, (7) DBP, (8) CHOP-10, (9) CREB, (10) C/EBP, (11) PAR, (12) ATF2, (13) c-myc, (14) n-myc, (5) l-myc, (16) max, (17) mad, (18) ID, (19) MyoD1, (20) E12, (21) AP-4, (22) TFE3, (23) USF, and (24) FIP.

If Applicants elect the claims of Group (I), the Office requires the election of a specific amino acid sequence of claim 37.

Alternatively, if Applicants elect the claims of Group (II), the Office requires an election of one of the following amino acid sequences: SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3, SEQ ID NO:7, SEQ ID NO:11, SEQ ID NO:17, SEQ ID NO:19, SEQ ID NO:23, SEQ ID NO:25, SEQ ID NO:29, SEQ ID NO:35, SEQ ID NO:36, SEQ ID NO:37, SEQ ID NO:38, SEQ ID NO:39, SEQ ID NO:40, SEQ ID NO:41, SEQ ID NO:42, SEQ ID NO:53, SEQ ID NO:54, SEQ ID NO:57, and SEQ ID NO:64.

The Office indicates that upon the allowance of linking claims, the restriction requirement as to the linked invention will be withdrawn, and any claims depending from or otherwise including the limitations of the allowable linking claims will be entitled to examination in the application.

Election in Response to Restriction Requirement

Applicants hereby elect, with traverse, the claims of Group (II) (claims 28-56), the Fos protein (claims 28-34, 37-52, and 54-56), and SEQ ID NO:19 (claims 28-40, 43-51, and 54-56).

Discussion of the Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, *and* (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*" (M.P.E.P. § 803, emphasis added).

In the case at hand, the Office fails to meet the above-identified criteria and to present the required supporting evidence and reasoning. There is significant overlap in subject matter between the Groups (I) and (II), such that references considered during the examination of the claims of one group likely would be considered during the examination of the claims of the other group. For example, a search of the prior art for references relevant to an acidically modified nucleic acid binding protein containing an N-terminal extension of acidic amino acid residues (e.g., an acidically modified bZIP protein) is relevant to both Groups (I) and (II). Likewise, the specific dominant negative proteins recited in the claims of Group (I) and the claims of Group (II) are the same. Therefore, a prior art search with respect to a specific protein will identify art that would undoubtedly be considered with respect to both groups as they pertain to that specific protein. The same also can be said for the specific amino acid sequences recited in the claims of both groups. In this regard, Applicants point out that the claims of Groups (I) and (II) are classified in the same class. This is not to say that the claims stand or fall together. Rather, the overlap in the relevance of references and the overlap in the classification of the claimed subject matter suggests that there is no need for a restriction requirement.

Furthermore, the requirement for Applicants to select a specific sequence corresponding to N-terminal extensions of acidic amino acids from the claims of Group (II) is improper. As set forth in M.P.E.P. 803.02, unity of invention exists if all species recited in a claim (1) show a common utility (e.g., the addition of an N-terminal extension of acidic amino acids to a nucleic acid binding protein allows for dimerization or multimerization of the protein with a normal cellular protein), and (2) a substantial structural feature essential to

that utility (e.g., the N-terminal extension of acidic amino acid residues). Therefore, the pending claims demonstrate unity of invention relative to the specific sequences recited in the pending claims.

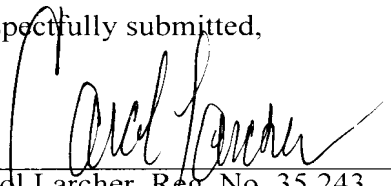
Similarly, the requirement to select a specific protein is improper, since the proteins (1) show a common utility (e.g., binding to a nucleic acid sequence), and (2) a substantial structural feature essential to that utility (e.g., nucleic acid binding domains). Therefore, the pending claims demonstrate unity of invention relative to the specific proteins recited in the pending claims.

Thus, the Office has failed to meet the criteria for a proper requirement for restriction. Applicants respectfully submit that the requirement for restriction is improper and should be withdrawn.

Conclusion

Under the circumstances, Applicants request the withdrawal of the restriction requirement, in whole or in part, and consideration of other of the pending claims in addition to those of elected Group (II) corresponding to the Fos protein and SEQ ID NO:19. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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